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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/215,569

12/16/1998

ETHAN BIER

07349/019001

7230

30542

7590

07/11/2002

FOLEY & LARDNER  
P.O. BOX 80278  
SAN DIEGO, CA 92138-0278

EXAMINER

ROMEO, DAVID S

ART UNIT

PAPER NUMBER

1647

DATE MAILED: 07/11/2002

21

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/215,569

Applicant(s)

BIER ET AL.

Examiner

David S Romeo

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1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 3-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 11 January 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on 11 January 2002 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

The finality of the rejection of the last Office is withdrawn, in order to make a new grounds of rejection that follows.

5           The amendment filed May 22, 2002 (Paper No. 19) has been entered in part. The amendments to page 21 of the specification have not been entered because original page 21 was cancelled in the amendment filed April 27, 2000 (Paper No. 6). The remainder of the amendments have been entered. Claims 1-26 are pending. Claims 3-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention,  
10   there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 14. Claims 1 and 2 are being examined. Any objection and/or rejection of record that is not maintained and/or repeated in this Office action is withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action. Citations by the examiner are in an alphanumeric format, such as  
15   "(a1)", wherein the "a" refers to the reference cited on the Notice of References Cited, PTO-892, and the "1" refers to the Paper No. to which the Notice of References Cited, PTO-892, is attached.

#### **Maintained Formal Matters, Objections, and/or Rejections:**

20           The amendment filed 12/22/2000 (Paper No. 11, the response to the notice to comply) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure.

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The amendment filed 01/11/2002 (Paper No. 16) is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

Applicants argue that neither the sequence listing nor the formal drawings constitute new matter because both the sequence listing and the drawings replicate the exact content of Figures 1-6 as originally filed. Applicants arguments have been fully considered but they are not persuasive. Because the figures in the original disclosure are illegible, unreadable, and indecipherable there is no basis in the original disclosure for the later filed sequences in the paper copy and computer readable form of the sequence listing and in the formal drawings. The later filed sequences in the paper copy and computer readable form of the sequence listing are matter not in the original specification. Hence, the later filed sequences are new matter. In contrast to the situation in *In re WRIGHT*, 145 USPQ 182 (CCPA 1965), in the present case there is neither an inherent nor an implicit disclosure of the later filed sequences in the original sequences because the original sequences are illegible, unreadable, and indecipherable. Contrary to Applicants' assertion, the originally filed sequences have been changed from illegible, unreadable, and indecipherable sequences to legible, readable, and decipherable sequences and there is no basis in the illegible, unreadable, and indecipherable originally filed sequences for the later filed sequences. It is acknowledged that the sequences were retyped by a word-processor having no technical background, but it is not clear that the originally filed sequences were used for re-typing and it is unclear how an illegible, unreadable, and indecipherable sequence could be re-typed. In the present case where the originally filed drawings were of such poor quality such that the disclosure of the sequences therein is illegible, unreadable, and indecipherable, such a

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defect cannot be cured by submitting an amendment seeking to put into the specification something required to be there when the patent application was originally filed.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter  
5 which was not described in the specification in such a way as to reasonably convey to one skilled  
in the relevant art that the inventor(s), at the time the application was filed, had possession of the  
claimed invention. Applicants argue that the specification at page 6, lines 16-18, discloses  
Super-Sog that has been synthesized chemically. Applicants arguments have been fully  
considered but they are not persuasive. The specification at page 6, lines 16-18 discloses, Super-  
10 Sog polypeptide that has been synthesized chemically. This is not a disclosure of a "synthetic"  
polynucleotide. Synthetic implies preparation by automated instruments sold by a variety of  
manufacturers. See Maniatis (u21), page 11.20, first sentence. There is no original disclosure of  
a polynucleotide prepared by automated instruments. The scope of the term "synthetic" is  
broader than that of the isolated or purified polynucleotide originally disclosed and raises the  
15 issue of new matter.

**New formal matters, objections, and/or rejections:**

Claims 1, 2 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter  
which was not described in the specification in such a way as to reasonably convey to one skilled  
20 in the relevant art that the inventor(s), at the time the application was filed, had possession of the  
claimed invention. The amendment filed 12/22/2000 (Paper No. 11, the response to the notice to  
comply) and the amendment filed 01/11/2002 (Paper No. 16) introduce new matter into the

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disclosure, as discussed above and in the previous Office actions. Insofar as SEQ ID NO: 1 in claim 1 refers to the material in the amendment filed 12/22/2000 (Paper No. 11, the response to the notice to comply) and/or in the amendment filed 01/11/2002, then the recitation to SEQ ID NO: 1 in the claims introduces new matter into the disclosure.

5

**Conclusion**

No claims are allowable. SEQ ID NO: 1 is free of the prior art of record.

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ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (703) 305-4050. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M.

IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (703) 308-4623.

15

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE FOLLOWING TC 1600 BEFORE AND AFTER FINAL RIGHTFAX NUMBERS:

BEFORE FINAL (703) 872-9306

AFTER FINAL (703) 872-9307

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IN ADDITION TO THE OFFICIAL RIGHTFAX NUMBERS ABOVE, THE TC 1600 FAX CENTER HAS THE FOLLOWING OFFICIAL FAX NUMBERS: (703) 305-3592, (703) 308-4242 AND (703) 305-3014.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (703) 308-0294.

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ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

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DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647